

REMARKS

Claims 1-21 are pending in the application. Claim 7 has been amended and no claims have been cancelled. No new claims have been added.

Allowable Subject Matter

The Examiner indicated that claims 11-20 are allowed.

Claim Rejections – 35 USC § 102

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamada et al. (6,559,662). The applicants disagree.

Yamada does not teach each and every element of claim 1. Claim 1 recites the element of analyzing a *composition of the first defect* using the semiconductor defect inspection instrument (emphasis added). In Yamada, an electron beam is directed at a semiconductor defect to measure the amount of current passing through a contact hole or via-hole.

It appears that the meaning of composition is again at issue. The words of a claim must be given their plain meaning unless they are defined in the specification (MPEP 2111.01). Plain meaning refers to the meaning given to the term by those of ordinary skill in the art (MPEP 2111.01). No term in a claim may be given a meaning repugnant to its usual meaning. MPEP 2173.05(a), *citing In re Hill*, 161 F.2d 367 (CCPA 1947).

In this case, interpreting the term “composition” to mean “conductivity” is both repugnant to its usual meaning and contrary to the plain meaning of the term. In the context of claim 1 those of ordinary skill in the art would probably interpret “a composition of the defect” to mean “what the defect is composed of” or “what the defect is made of.” The American Heritage Dictionary of the English Language (4th. Ed., 2000) supports this conclusion because the most relevant definition is “the combining of distinct parts or elements to form a whole.” In other words, “composition” refers to the internal structure of the defect. Therefore, Yamada does not teach each and every element of the invention.

Therefore, Yamada does not anticipate claim 1 because Yamada does not expressly or inherently teach each and every element as set forth in claim 1 (see, e.g., MPEP 2131 - “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”).

Claims 2-6 depend from claim 1. Consequently, Yamada also fails to anticipate these claims for at least the reason that Yamada does not teach each and every element that is inherent to the claims. MPEP 2131.

Claim 7 has been amended to clarify that the marking identifies a type *and a composition* of the defect. Using the marking that identifies a type and a composition of the defect is disclosed in on page 4, lines 5-15. Yamada does not teach each and every element of amended claim 7 for at least similar reasons as claim 1.

Claims 8-10 depend from claim 7. Consequently, Yamada also fails to anticipate these claims for at least the reason that Yamada does not teach each and every element that is inherent to the claims. MPEP 2131.

Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by Simmons (6,265,232). The applicants disagree.

Simmons does not teach each and every element of claim 21. Claim 21 recites the element of determining *a composition* of the wafer defects (emphasis added). Simmons does not teach each and every element of claim 21 for at least similar reasons as claim 1, namely Simmons does not teach determining a composition of the wafer defects. Therefore, Simmons does not anticipate claim 1 because Simmons does not expressly or inherently teach each and every element as set forth in claim 21. MPEP 2131.

Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-10 and 21 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 20575

Respectfully submitted,
MARGER JOHNSON & McCOLLOM, P.C.



Hosoon Lee
Limited Recognition Under 37 CFR § 10.9(b)

MARGER JOHNSON & McCOLLOM, P.C.
1030 SW Morrison Street
Portland, OR 97205
503-222-3613

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Angie C. Farr